In the

United States Court of Appeals

For the Seventh Circuit

No. 9991

THE DAVISON CHEMICAL CORPORATION, *Plaintiff-Appellant,* *vs.* JOLIET CHEMICALS, INC., DES PLAINES OIL COMPANY, JOLIET CHEMICALS, LTD., and KENNETH F. NASH, *Defendants-Appellees.*	Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

PETITION FOR REHEARING.

The opinion of this Court sounds the death knell for all chemical process patents.

In substance the Court holds that the test of invention is to be applied only to the means by which the underlying principle in a patent for a chemical process is brought into play. The artisan is to be given the benefit of the inventor's analysis of the defects in existing processes and his discovery of the scientific principles which control their solution. If the artisan can then be expected to devise the process of the patent in suit, the patent is invalid.

No patent for a chemical process can meet this test. Such patents have to do with the creation of new compounds or improved processes for the creation of existing compounds or changes in the physical properties of compounds previously known. Once the basic scientific principle is ascertained and clearly stated, all else is obvious.

As an illustration we may take the prior patent to Patrick relied upon in this case as an anticipation. Prior to Patrick an excess of acid was used in the manufacture of silica gel in order to prevent premature setting. It was then necessary to remove the excess acid by dialysis.

Patrick analyzed the defects in the existing process. He discovered that agitation would prevent the premature setting of the mixture. Any skilled worker in the field could devise means of agitation to carry out Patrick's discovery. In fact the specific means that might be used are so obvious that Patrick described them in his specifications by the general term "stirring".

Assume that an inventor discovers that a chemical process may be expedited by the use of a catalyst. What is there left in the way of invention to implement such a discovery? Any trained chemist would know how to introduce a catalyst into a manufacturing process.

This is equally true of the case at bar or any other case in which an inventor discovers that control of temperature at a particular stage of a process will improve the result. There could be no invention in the means of providing the temperature.

All of the leading cases on process patents in the Supreme Court can be reduced to the discovery of a "principle of nature". After the "principle" has been taught any one skilled in the art could have developed the means.

Mowry v. *Whitney*, 14 Wall (81 U. S.) 620: The tan-

gential injection of molten metal into a mould gives it a rotary motion and causes the dross to be thrown to the center of the casting.

Tilghman v. *Proctor,* 102 U. S. 707: Hot water and pressure will separate fat acids and glycerine from animal fat.

Providence Rubber Co. v. *Goodyear,* 9 Wall (76 U. S.) 788: India rubber can be cured by subjecting it to a high degree of artificial heat.

Carnegie Steel Co. v. *Cambria Iron Co.,* 185 U. S. 403: Substantial uniformity from a plurality of blast furnaces can be maintained by using a common dominant pool.

In the *Cambria* case the Court held that it was a part of the essential nature of a process patent that: "The directions and specifications of such a patent are addressed to those skilled in the art. It professes to disclose a method of procedure, not the particular instrumentality that may be employed." (185 U. S. at p. 441.)

Robinson in describing the essential nature of an art or process stresses the unimportance of means:

> "It is so far abstract that it is capable of contemplation by the mind apart from any one of the specific instruments by which it is performed." I Robinson, Patents § 159.

Invention may be largely in the discovery of the source of trouble. From that point the solution may be fairly obvious as in *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.,* 261 U. S. 45, 68:

> "The invention was not the mere use of a high or substantial pitch to remedy a known source of trouble. It was the discovery of the source not before known and the application of the remedy for which Eibel was entitled to be rewarded in his patent."

And afterward, to-wit, on the second day of March, 1950, there was filed in the office of the Clerk of this Court an answer to the petition for rehearing, which said answer is in the words and figures following, to-wit:

In the

United States Court of Appeals

For the Seventh Circuit

No. 9991

THE HAVEGON CHEMICAL CORPORATION, a corporation, *Plaintiff,* vs. JULIET CHEMICALS, INC., a corporation, et al., *Defendants.*	Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

REPLY TO PETITION FOR REHEARING.

JULES L. STRAUS,
JOHN REX ALLEN,
Attorneys for Defendants-Appellees.

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FILED
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KENNETH J.

In the

United States Court of Appeals

For the Seventh Circuit

No. 9991

THE DAVISON CHEMICAL CORPORATION, a corporation, *Plaintiff,* vs. JOLIET CHEMICALS, INC., a corporation, et al., *Defendants.*	Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

REPLY TO PETITION FOR REHEARING.

The petition for rehearing dramatically starts off with the completely unfounded statement that the opinion of this Court "sounds the death knell for all chemical process patents."

In alleged support of such statement the petition mentions a number of Supreme Court cases which it is apparently claimed would have been decided differently if the principle of law laid down in the case of *Funk Bros. Seed Co.* v. *Kalo Inoculant Co.*, 333 U. S. 127 and in the Court's opinion in the present case had been followed. It is interesting to note that only one of these Supreme Court cases dealt with a process that would properly be termed "chemical." That case was *Tilghman* v. *Proctor*, 102 U. S. 707, 26 L. Ed. 288 and of the patent involved the Court said:

"Let us apply these principles to the present case. *In the first place, the claim of the patent is not for a mere principle.* The chemical principle or scientific fact upon which it is founded is, that the elements of neutral fat require to be severally united with an atomic equivalent of water in order to separate from each other and become free. *This chemical fact was not discovered by Tilghman.* He only claims to have invented a particular mode of bringing about the desired chemical union between the fatty elements and water." (Italics ours.)

These and the other cases mentioned in the petition for rehearing are likewise not pertinent because each involved a *new* step or an *unobvious changed* step or element. The last case mentioned, *Copeman Laboratories Co.* v. *General Plastics Corporation,* 149 F. 2d 962 involved a rather limited claim to an ice cube tray of a certain size and formed of non-metallic, easily distortable, self-supporting material to which ice does not readily adhere. We are unable to find anything in the opinion which indicates that the patentee claimed to be the discoverer of any law or principle of nature.

It is clear that the decision of this Court is entirely sound and in accordance with the established, applicable law laid down by the Supreme Court and other Federal Courts.

Respectfully submitted,

JULES L. BRADY,
JOHN REX ALLEN,
Attorneys for Defendants-Appellees.

And afterward to-wit, on the seventh day of March, 1950, the following further proceedings were had and entered of record, to-wit:

UNITED STATES COURT OF APPEALS

For the Seventh Circuit,

Chicago 10, Illinois.

March 7, 1950.

Before:

Hon. J. Earl Major, Chief Judge.
Hon. Philip J. Finnegan, Circuit Judge.
Hon. Walter C. Lindley, Circuit Judge.

The Davison Chemical Corporation, *Plaintiff-Appellant,* vs. Joliet Chemicals, Inc., Des Plaines Oil Company, Joliet Chemicals, Ltd., and Kenneth F. Nash, *Defendants-Appellees.*	Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

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It is ordered by the Court that the petition for rehearing of this cause be, and the same is hereby denied.

And afterward, to-wit, on the fifteenth day of March, 1950, the mandate of this Court issued to the United States District Court for the Northern District of Illinois, Eastern Division.

UNITED STATES COURT OF APPEALS

For the Seventh Circuit,

Chicago 10, Illinois.

I, Kenneth J. Carrick, Clerk of the United States Court of Appeals for the Seventh Circuit, do hereby certify that the foregoing printed pages contain a true copy of papers filed and proceedings had, excepting motions and orders relating to filing of briefs and briefs of counsel, in:

Cause No. 9991.

The Davison Chemical Corporation,
Plaintiff-Appellant,

vs.

Joliet Chemicals, Inc., *et al.*,
Defendants-Appellees,

as the same remains upon the files and records of the United States Court of Appeals for the Seventh Circuit.

In Testimony Whereof I hereunto subscribe my name and affix the seal of said United States Court of Appeals for the Seventh Circuit, at the City of Chicago, this 23rd day of May, A. D. 1950.

(Seal)

Kenneth J. Carrick,
Clerk of the United States Court of Appeals for the Seventh Circuit.